

Application No: 09/876,515
Attorney's Docket No: GB 000109

REMARKS

Applicant acknowledges receipt of the Final Office Action dated 02/24/2006. Claims 1-14 were pending in the application and are presented for reconsideration and further examination in view of the following remarks and arguments.

By this Response and Amendment the rejection of claims 1-14 under 35 U.S.C. § 103(a) is respectfully traversed.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being obvious over US Patent 5,835,861 to Whiteside, hereinafter noted "Whiteside," in view of US Patent 6,169,498 to King et al., hereinafter noted "King."

Applicant respectfully traverses these rejections.

Independent claims 1, 10 and 11 are directed to a communication system, a beacon device and a method for enabling data delivery through beacons. The system comprises the beacon device and at least one portable device. The beacon device broadcasts a series of inquiry messages in the form of a plurality of predetermined data fields arranged according to a communications protocol, and adds to each inquiry message an additional data field including location information. The portable device is arranged to receive the transmitted inquiry messages and read the additional data field including the location information. Dependent claim 8 depends from claim 1 and is directed to a mobile communication device such as the portable device recited in claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

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expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Applicant will show that the Examiner has not established a *prima facie* case of obviousness because the prior art references cited by the Examiner do not teach or suggest all the claim limitations, as recited in independent claims 1, 10 and 11, or in any of their respective dependent claims.

1. Claims 1, 8, 10 and 11:

Applicant respectfully submits that Whiteside does not teach or suggest a beacon "arranged to broadcast a series of inquiry messages" as recited in, e.g., claim 1. What Whiteside discloses is a method of transmitting advertising information from a billboard to a wireless telephone. Whiteside describes two embodiments. In a first embodiment, an "infrared transceiver simply broadcasts the telephone number of the vendor continuously." See Col. 2:13-16. In a second embodiment, the method comprises: "receiving a signal transmitted from a wireless telephone at a billboard, said signal being other than the regular wireless frequency band and, in response to receiving said signal, automatically transmitting a second signal from said billboard that is to be received and stored by said wireless telephone." See Col. 3:22-32 and Col. 2:26-30. In other words, the billboard in Whiteside does not broadcast inquiry messages, but instead it either simply broadcasts advertising information continuously, or it sends back a signal that includes the advertising information in response to a signal received from a wireless telephone. There is no teaching or suggestion that the billboard in Whiteside would broadcast inquiry messages.

Furthermore, Applicant submits that Whiteside does not teach or suggest the inquiry messages being "in the form of a plurality of predetermined data fields arranged according to a first communications protocol," or that "the beacon is further arranged to add to each inquiry message prior to transmission an additional data field," as recited in claims 1, 10 and 11. What Whiteside discloses is just that the signal broadcast from the billboard to the wireless telephone "can also be used to convey other data, such as a bank interest rate, current product cost," and

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that the message transmitted from the wireless telephone to the billboard "can also be enhanced to make a more specific request for one of the items of information that can be supplied by the billboard." See Col. 2:35-39. In other words, Whiteside only describes the various types of information that can be exchanged between the wireless telephone and the billboard. Whiteside does not teach or suggest what kind of structures and/or protocols are used to transmit that information. In particular, Whiteside is silent about adding an additional data field prior to transmission, as recited in claims 1, 10 and 11.

The Examiner admits that "Whiteside does not teach the additional data field including location information," and relies upon King for that feature. Applicant submits that King, not only does not cure the other deficiencies previously pointed out in Whiteside, but it does not teach or suggest "the additional data field including location information" either. King is directed to a method for communicating location-specific messages. However, the method taught by King requires "storing a library of such messages within a portable device having a capability of randomly accessing the messages." See, e.g., Abstract, lines 1-4; and claims 1, 8 and 9 of King. In other words, the location-specific messages disclosed by King are already stored in the portable device, they are not sent from a beacon to the portable device, as recited in claims 1, 10 and 11 of the application.

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness because the prior art references cited by the Examiner do not teach or suggest all the claim limitations, as recited in independent claims 1, 10 and 11. Applicant also submits that claim 8, which depends from 1, is patentable over the cited art references for at least the reasons stated above in connection with claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 8, 10 and 11 is respectfully requested.

2. Claims 2-3 and 12-13:

Claims 2-3 and 12-13 depend, respectively, from claims 1 and 11, and are therefore also patentable over the cited art references for at least the reasons stated above in connection with claims 1 and 11, as well as for the separately patentable subject matter recited therein. In particular, and contrary to the Examiner's assertion, Applicant submits that Whiteside does not

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teach or suggest "the beacon is arranged to add said additional data field at the end of a respective inquiry message," as recited in claims 2 and 12. Furthermore, there is absolutely no teaching or suggestion in Whiteside of a beacon "arranged to include an indication in one of said predetermined data fields, said indication denoting the presence of said additional data field," as recited in claims 3 and 13. Moreover, Applicant respectfully submits that the citation provided by the Examiner in support for the rejection is completely irrelevant. At column 2, lines 35-39, Whiteside only states that, "Message 16 can also be used to convey other data, such as a bank interest rate, current product cost; message 15 can also be enhanced to make a more specific request for one of the items of information that can be supplied by the billboard."

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter recited in claims 2-3 and 12-13 because the prior art references cited by the Examiner do not teach or suggest all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claims 2-3 and 12-13 is respectfully requested.

3. Claims 4 and 14:

Claims 4 and 14 depend, respectively, from claims 1 and 11, and are therefore also patentable over the cited art references for at least the reasons stated above in connection with claims 1 and 11, as well as for the separately patentable subject matter recited therein. In particular, and contrary to the Examiner's assertion, Applicant submits that Whiteside does not teach or suggest "wherein said communications protocol comprises Bluetooth messaging," as recited in claims 4 and 14. What Whiteside teaches at column 1, lines 48-49 is that "Communications in both directions are via a modulated infrared signal," which teaches away from a Bluetooth protocol. Bluetooth is an industrial specification for wireless networks, also known as IEEE 802.15.1, that provides a way to connect and exchange information between devices via a short range **radio frequency**, whereas Whiteside teaches communications via an **infrared signal**.

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter recited in claims 4 and 14 because the prior art references

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cited by the Examiner do not teach or suggest all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claims 4 and 14 is respectfully requested.

4. Claims 5 and 7:

Claims 5 and 7 depend, respectively, from claims 4 and 1, and are therefore also patentable over the cited art references for at least the reasons stated above in connection with claims 4 and 1, as well as for the separately patentable subject matter recited therein. In particular, and contrary to the Examiner's assertion, Applicant submits that Whiteside does not teach or suggest "a special Dedicated Inquiry Access Code (DIAC) is used to indicate the presence of location information in the additional data field," as recited in claim 5. Furthermore, there is absolutely no teaching or suggestion in Whiteside that the "wireless messaging system employs frequency hopping, and further wherein location data is sent on each frequency used for inquiry message broadcasts," as recited in claim 7. Moreover, Applicant respectfully submits that the citation provided by the Examiner in support for this rejection is again completely irrelevant. At column 1, lines 48-49, Whiteside only states that, "Communications in both directions are via a modulated infrared signal."

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter recited in claims 5 and 7 because the prior art references cited by the Examiner do not teach or suggest all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claims 5 and 7 is respectfully requested.

5. Claim 6:

Claim 6 depends from claim 1 and is therefore also patentable over the cited art references for at least the reasons stated above in connection with claim 1, as well as for the separately patentable subject matter recited therein. In particular, and contrary to the Examiner's assertion, Applicant submits that King does not teach or suggest "wherein the presence of location information in the additional data field is indicated with header information appearing in the additional data field," as recited in claim 6. The Examiner already admitted that Whiteside does not teach this feature, and Applicant submits that there is absolutely no teaching or suggestion of this feature in King either. Once again, the citation provided by the Examiner in

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support for this rejection is completely irrelevant. What King discloses in the Abstract, lines 17-22 is just that, "The fixed map information and the time-dependent information may then be accessed to locate a particular site specified by the time-dependent information. For example, the map information may include gate locations within an airport and the time-dependent information may include flight arrival and departure times."

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter recited in claim 6 because the prior art references cited by the Examiner do not teach or suggest all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claim 6 is respectfully requested.

6. Claim 9:

Claim 9 depends from claims 1 and 8 and is therefore also patentable over the cited art references for at least the reasons stated above in connection with claims 1 and 8, as well as for the separately patentable subject matter recited therein. In particular, and contrary to the Examiner's assertion, Applicant submits that Whiteside does not teach or suggest "wherein the receiver is configured to receive messages according to Bluetooth protocols," as recited in claim 9. What Whiteside teaches at column 1, lines 48-49 is that "Communications in both directions are via a modulated infrared signal," which teaches away from a Bluetooth protocol. Bluetooth is an industrial specification for wireless networks, also known as IEEE 802.15.1, that provides a way to connect and exchange information between devices via a short range **radio frequency**, whereas Whiteside teaches communications via an **infrared signal**.

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness against the subject matter recited in claim 9 because the prior art references cited by the Examiner do not teach or suggest all the claim limitations. Accordingly, reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

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While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.



Terry W. Kramer
Registration No.: 41,541

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KRAMER & AMADO, P.C.
1725 Duke Street, Suite 240
Alexandria, VA 22314
Phone: 703-519-9801
Fax: 703-519-9802